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10/594,508	09/28/2006	Yuichi Inada	59559.00039	1763
32294 7590 07/14/2008 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT DRIVE 14TH FLOOR VIENNA, VA 22182-6212				
EXAMINER				
BODAWALA, DIMPLE N				
ART UNIT		PAPER NUMBER		
1791				
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07/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/594,508

Applicant(s)

INADA ET AL.

Examiner

DIMPLE N. BODAWALA

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-11 and 13-18 is/are pending in the application.
4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 7-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 7-11 and 13-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SI-08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

In view of the amendment, filed on 4/14/2008 following rejections are withdrawn as a reason of record from the previous office action, mailed on 12/13/2007.

- ✓ Rejection of claims 7-11 under 35 USC 112, second paragraph.
- ✓ Rejection of claims 7-11 under 35 USC 102(b) as being anticipated by Maruyama et al. (US 5,006,058).

In view of the amendment, filed on 4/14/2008 following objection are withdrawn as a reason of record from the previous office action, mailed on 12/13/2007.

- ✓ Objection of PTOL-1449 from.

Response to Arguments

1. Applicant's arguments, see Remarks, filed on 4/14/2008, with respect to the rejection(s) of claim(s) 7 under 102(b) have been fully considered and are persuasive.
2. Applicant argues that the prior art, Maruyama et al. (US 5,006,058) fails to disclose or suggest at least, a first region provided to extend radially outward from an outer circumferential edge of the through hole projects from a second region provided to extend radially outward from the first region so as to form a step between the first and second regions. Applicant's arguments are fully considered and found persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as follows:

Election/Restrictions

3. Claims 1-6 and 12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected a mold for molding a disk and a molded product produced by

chagrining a molding material into a cavity of a mold for molding disk, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/14/2008 and the previous office action mailed on 12/13/2007.

4. Newly submitted claims 13-18 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Invention Group I (claims 7-11) and Invention group II (claims 13-18) are distinct from each other, and there is no single inventive concept, either claims do not have the same technical feature or that the claims are obvious or anticipated by references such as (US 5,882,700) and (US 4,452,748).

5. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13-18 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Information Disclosure Statement

6. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

7. IDS is objected because disclosure of the instant applicant discloses foreign document such as JP 2002-222545, but does not cite on the IDS form.

New Ground of Rejections

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claim 8 is vague and indefinite because it is unclear which element having a front end surface with a groove.
11. Claim 8 recites the limitation "the front end surface" in line 3. There is insufficient antecedent basis for this limitation in the claim, because claim 8 is depended on claim 7, wherein claim 7 fails to cite such limitation, and, therefore, such limitation makes the scope of the subject matter indeterminate.

Claim Rejections - 35 USC § 102

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 13. Claims 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue (JP 2001-150488).**
14. As to claim 7, Inoue discloses an injection molding apparatus which comprises first mold plate; second mold plate; stamper (3); first mirror surface disk (15) attached to the first mold plate (2); a second mold plate (1) disposed to advance and retreat in relation to the first mold plate (2); a second mirror surface disk attached to the second mold plate and forming a cavity (13) in co-operation with the first mirror surface disk in a mold clamped condition; a stamper (3)

attached to the mirror surface disk and having a fine pattern formed on a front end surface thereof; a bush (8,10) extending through the mirror surface disk (See figure 1); and the other mirror surface disk comprises a through hole that disposes the bush is formed radially inward of a region for forming clamp area (See figure 6-7). Figure 7 shows that the a first region provided to extend radially outward from an outer circumferential edge of the through hole projects from a second region provided to extend radially outward from the first region so as to form a step between the first and second regions.

15. As to claims 8-9, Figure 7 shows that the front end surface of the other mirror surface disk comprises annular groove (23), which is involved to form a stack rib, wherein groove is formed between the first and second region, and the first region is a region that forms a clamp area.

16. Inoue discloses all claimed structural limitations as discussed above, and, thus, the claims are anticipated.

17. Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Asai (US 5,460,763).

18. As to claim 7, Asai ('763) discloses a disc mold which comprises first mold plate; a first mirror surface disc attached to the first mold plate; a second mold plate disposed to advanced and retreat in relation to the first mold plate; a second mirror surface disc attached to the second mold plate and forming a cavity in co-operation with the first mirror surface disc in a mold clamped condition (See figure 1); a stamper attached to one of the first and second mirror surface discs and having a fine pattern formed one a front end surface thereof (See figure 1); and a bush extending through another one of the first and second mirror surface discs (See figure 12). It

further teaches that the other mirror surface disc being characterized in that a through hole that disposed the bush is formed radially inward of a region for forming a clamp area (See figure 12).

It further teaches that first region provided to extend radially outward from an outer circumferential edge of the through hole projects from a second region provided to extend radially outward from the first region so as to form a step between the first and the second regions (see figures 5, 8 and 11).

19.

20. As to claim 8, it further teaches that the groove (10C) formed on the front end surface of a mirror surface disc at a predetermined location (See figures 5, 8 and 11).

21. As to claim 9, it further teaches that groove is formed between the first and second regions; and the first region is a region that forms the clamp area (see figures 5, 8 and 11).

22. As to claims 10-11, Figure 11 further suggests that the groove is formed in first and second regions.

23. Asai discloses all claimed structural limitations as discussed above, and, thus, the claims are anticipated.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

26. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

27. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (JP 2001-150488).

28. Inoue discloses all claimed structural limitations as discussed above. It further teaches that the groove is formed between first and second region, but fails to teach or suggest that first and second region comprise groove.

29. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the invention of Inoue by providing groove in first and second regions because such an alignment is involved to provide a clearance between stack mold which is involved to form clamp area and signal area as required.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIMPLE N. BODAWALA whose telephone number is (571)272-6455. The examiner can normally be reached on Monday - Friday at 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PHILLIP C. TUCKER can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner
Art Unit 1791

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/Philip C Tucker/

Application/Control Number: 10/594,508

Page 9

Art Unit: 1791

Supervisory Patent Examiner, Art Unit 1791